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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/829,026

04/20/2004

Douglas F. Bateson

36287-04601

5972

27171

7590

09/30/2008

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EXAMINER

SHRESTHA, BIJENDRA K

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,026	Applicant(s) BATESON ET AL.	
	Examiner BIJENDRA K. SHRESTHA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Acknowledgement is made of applicant's claim for priority to Provisional Application 60/464,543 filled on 04/22/2003 under 35 U.S.C. 119(e).

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 1, 20, 24 and 42, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or

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positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

3. Claims 50-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 50-61 recite "computer executable software code...comprising: code to provide a stabilized return....; code to provide a second return...; and code to adjust the holdings....." These claims are non-statutory because it is directed towards software, per se, lacking storage on a medium, which enables any underlying functionality to occur. It is not clear whether instructions are in executable form and therefore there is no practical application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koppes et al., U.S. Patent No. 5,926,792 (reference A in attached PTO-892) in view of Petzal (Pensions & Investments) (reference U in attached PTO-892) further in view of Treynor, U.S. Patent No. 7,143,061 (reference B in attached PTO-892).

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6. As per claim 1, 20, 24 and 42, Koppes et al. teach a method for coordinated investment, the method comprising:

Providing / receiving a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account (see column 2, lines 53-67 to column 3, lines 1-4; column 4, lines 59-67; where Stable value Protected Funds smooth the returns of investments in separate accounts of life insurance company).

Providing/receiving a second return (see column 2, lines 66-67 to column 3, lines 1-4; where Stable Value Protected Investment provides second returns).

Koppes et al. do not teach the method where the second return is substantially based on value of an established index and value of a notional investment.

Petzel teaches the method where the second return is substantially based on value of an established index and value of a notional investment (Petzel, page 1, last two paragraph to page 2, first paragraph; where second return is based on \$ 100 million notional value investment in S&P 500 index for total return swap).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method where the second return is substantially based on value of an established index and value of a notional investment of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

Koppes et al. do not teach the method of adjusting the holdings of fluctuating return assets in response to a change in the second return.

Treynor teaches the method of adjusting the holdings of fluctuating return assets in response to a change in the second return (Treynor, Fig. 2; abstract).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method of adjusting the holdings of fluctuating return assets in response to a change in the second return of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

7. As per claim 2-7 and 25-30, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not teach a method comprising receiving LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; receiving LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return.

Petzel teaches a method comprising receiving LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; receiving LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return (Petzel, page 2, paragraph 3-5; where manager earns LIBOR + 1.5% and 15% return on S&P 500 while it pays LIBOR 5% to swap counterparty; if S&P 500 declines, the manager earns LIBOR +1.5% and negative return (-10%) and pays 5% to swap counterparty).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a method comprising receiving LIBOR plus a percentage; the percentage is a spread; receiving LIBOR plus a percentage is linked to providing the second return; receiving LIBOR minus a percentage; the percentage is a spread; and receiving LIBOR minus a percentage is linked to providing the second return of Koppes et al. because Petzel teaches that inclusion of these features would enable to investment manager to generate alpha such that final outcome is target benchmark return plus the alpha (Petzel, page 2, paragraph 6, last sentence).

8. As per 8-9, and 31-32, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above. Koppes et al. further teach the method comprising receiving a fee linked to providing the stabilized return (see Fig. 12 , step 1220; column 3, lines 1-4; column 4, lines 65-67); and

the insurance carrier account is a separate account (see column 4, lines 59-61).

9. As per claim 10-12 and 33-35, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not teach the method wherein the second return is a total return swap on the established index, and based on the notional investment; the second return is a futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment.

Petzel teaches the method wherein the second return is a total return swap on the established index, and based on the notional investment; the second return is a

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futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment (Petzel, page 1, paragraph 1 and last two paragraph; page 2, paragraphs 1-3).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow the method wherein the second return is a total return swap on the established index, and based on the notional investment; the second return is a futures contract on the established index, and based on the notional investment; and the second return is a forward contract on the established index, and based on the notional investment of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

10. As per claim 13-16, 19 and 36-39, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above.

Koppes et al. do not a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month; the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets.

Treynor teaches a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month; the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return

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assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets (Treynor, Figs. 2-5).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a method wherein adjusting the holdings of fluctuating return assets occurs on a periodic basis; the periodic basis is substantially every month; the periodic basis is substantially every quarter; adjusting the holdings of fluctuating return assets in response to a change in the notional investment; and an insurance carrier holding the insurance carrier account adjusts the holdings of fluctuating return assets of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

11. As per 17-18 and 40-41, Koppes et al. in view of Petzel further in view of Treynor teach claim 1 as described above. Koppes et al. further teach the method wherein

a stable value provider provides the stabilized return; and a stable value provider provides the second return (see column 2, lines 59-67 to column 3, lines 1-4).

12. As per 21-23 and 43-45, Koppes et al. in view of Petzel further in view of Treynor teach claim 20, 42 as described above. Claims 21-23 are rejected under same rationale as claims 13-16 as described above.

13. As per claim 46-49, Koppes et al. teach a system for coordinated investment (see Fig. 1), the system comprising:

means for providing/receiving a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account (see column 2, lines 53-67 to column 3, lines 1-4; column 4, lines 59-67; where Stable value Protected Funds smooth the returns of investments in separate accounts of life insurance company);

means for providing/receiving a second return (see column 2, lines 66-67 to column 3, lines 1-4; where Stable Value Protected Investment provide second returns).

Koppes et al. do not teach that the second return is substantially based on value of an established index and value of a notional investment.

Petzel teaches a means where the second return is substantially based on value of an established index and value of a notional investment (Petzel, page 1, last two paragraph to page 2, first paragraph; where second return is based on \$ 100 million notional value investment in S&P 500 index for total return swap).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a means where the second return is substantially based on value of an established index and value of a notional investment of Koppes et al. because Petzel teaches that inclusion of these features would enable to create alpha and transport alpha onto the target by using swap contract (Petzel, page 1, abstract).

Koppes et al. do not teach a means for adjusting the holdings of fluctuating return assets in response to a change in the second return.

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Treynor teaches a means adjusting the holdings of fluctuating return assets in response to a change in the second return (Treynor, Fig. 1 and 2; abstract; column 6, lines 23-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to allow a means for adjusting the holdings of fluctuating return assets in response to a change in the second return of Koppes et al. because Treynor teaches that inclusion of these features would enable to maintain a portfolio that is time diversified in the sense the absolute risk associated with the portfolio stays approximately constant over time (Treynor, page 1, lines 43-48).

14. As per claim 50-57, Koppes et al. in view of Petzel further in view of Treynor teach system and method for providing/receiving a stabilized return in coordinated investment as described in claims 1-49 as described above.

The recitation of claims 50-59 claims execution of method/system using computer system and computer executable software code. Examiner notes that reference Koppes et al. (see Fig. 1; column 6, lines 44-67), Petzel, and Treynor (see Fig. 1; column 23-32) are capable of meeting claims limitation using computer system, computer readable media and computer executable software code. These claims are further rejected for no-statutory matter for software per se under USC 101 as described above.

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15. As per claim 58-61, Koppes et al. in view of Petzel further in view of Treynor teach system and method for providing/receiving a stabilized return in coordinated investment as described in claims 1-57 as described above. Koppes et al. further teach a programmed computer for coordinated investment), comprising:

a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory(see Fig. 1; Digital Storage Means (12), Central Processing Unit (6);

wherein the program code comprises:

code to provide a stabilized return on holdings of fluctuating return assets that are held by an insurance carrier account; code to provide a second return, where the second return is substantially based on value of an established index and value of a notional investment (see column 7, lines 53-67; where code to provide stabilized return on holding and other software can be stored for the method and system described in claim 1-49 described); and

code to adjust the holdings of fluctuating return assets in response to a change in the second return (Treynor, Fig.1; column 23-32).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosures. The following are pertinent to current invention, though not relied upon:

Clark et al. (U.S. Patent No. 7,376,609) teach maximization of a hedged investment budget for an index-linked insurance product.

Payne et al. (U.S. Patent No. 6,049,772) teach system to managing hedged investment for life insurance companies.

Payne (U.S. Pub No. 2003/0144947) teaches computer-based system for hedging and pricing customized basket exchange swaps.

Schoen et al. (U.S. Pub No. 2004/02255536) teach superstructure pool computer system.

Whaley et al. (U.S. Pub No. 2006/0100949) teach financial indexes and instruments based thereon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bijendra K. Shrestha whose telephone number is (571) 270-1374. The examiner can normally be reached on 7:00 AM-4:30 PM (Monday-Friday); 2nd Friday OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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/Alexander Kalinowski/
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